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10/692,164

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Debra Weissman

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10/18/2006

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EXAMINER

HARPER, LEON JONATHAN

ART UNIT

PAPER NUMBER

2166

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/692,164 | Applicant(s) WEISSMAN ET AL. | |
| | Examiner Leon J. Harper | Art Unit 2166 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 7/21/2006 has been entered. Claims 1-3,17 have been amended. Accordingly claims 1-19 are pending in this office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0126156 (hereinafter Stoltenberg) in view of 5684990 (hereinafter Boothby).

As for claim 1, Stoltenberg discloses: (a) comparing identity claims of at least two contact records (See paragraph 0027 note: table one is not an exhaustive list of fields

that can be used in comparing records). Stored in a computer operating system (See paragraph 0025 note: the computer/CPU must have an operating system). (c) displaying a dialogue box that identifies the possible duplicate contact records and includes an option for merging the possible duplicate records (See figure 3 and paragraph 0038 note: the merge tools is what returns potential duplicates via a user interface).

Although Stoltenberg does not materially differ from the claimed invention, the disclosure of (b) identifying possible duplicate contact records is more explicitly indicated in Boothby. Boothby discloses: (b) identifying possible duplicate contact records (See column 4 line 65- column 5 line 5). It would have been obvious to an artisan of ordinary skill in the pertinent art to have incorporated the teaching of Boothby into the system of Stoltenberg. The modification would have been obvious because many times user will store contact information in devices such as pda's or handheld computers and will also store the same or different information relating to the same entity in another location such as the office (See Boothby column 1 lines 16-22), or the existence of multiple records common to a single entity will result in "fragmented records" (See Stoltenberg paragraph 0005).

As for claim 2, the rejection of claim 1 is incorporated, and further Stoltenberg discloses: wherein the identity claims included in the at least two contact records

Art Unit: 2166

comprise phone numbers (See paragraph 0028 and see table 5 for all information that is shown in a record which can be used in a customizable comparison).

As for claim 3, the rejection of claim 1 is incorporated, and further Stoltenberg discloses: wherein the identity claims included in the at least two contact records comprise addresses (See paragraph 0028 and see table 5 for all information that is shown in a record which can be used in a customizable comparison).

As for claim 4 the rejection of claim 1 is incorporated, and further Boothby discloses: wherein a is performed after that data in a composite record is synchronized with data in a store (See column 5 lines 45-55 note that the composite record= status file, which is synchronized and then used again. Also note that this file has to be stored in memory which is a store since it may be accessed by an application).

As for claim 5, the rejection of claim 1 is incorporated, and further Stoltenberg discloses: wherein (a) is performed after receiving a command from a user (See paragraph 0037).

As for claim 6, the rejection of claim 1 is incorporated, and further Boothby discloses: wherein the at least two contact records consists of at least two composite records (See column 5 lines 47-49 one record per pair of synchronized records = one composite record per contact record).

As for claim 7, the rejection of claim 6 is incorporated, and further Stoltenberg discloses receiving a command to merge the possible duplicate records (See paragraph 0045); , and linking any publisher records that were linked to the at least two composite records to the single composite record (See paragraph 0055 note: all the new registration information is linked based on the merged records).

Moreover, Boothby discloses: merging the contact data from the at least two composite records into a single composite record (See column 6 lines 40-45, note that once the copying is done you now have two copies of the composite files).

As for claim 8, the rejection of claim 7 is incorporated, and further Boothby discloses: wherein the single composite record is one of at least two composite records (See column 6 lines 40-45, note that once the copying is done you now have two copies of the composite files, and See column 8 lines 47-51 note: the workspace and the status file are separate but become 1).

As for claim 9 the rejection of claim 1 is incorporated, and further Stoltenberg discloses: wherein the at least two contact records are part of a computer operating system (See paragraph 0025 note: the computer/CPU must have an operating system).

As for claim 10 Stoltenberg discloses: receiving an unmerge command from a user (See paragraph 0049 "unmerge button") identifying at least one publisher record

Art Unit: 2166

that the user wishes to unmerge from the original composite record (See paragraph 0049 note: "last group will be unmerged")

Boothby discloses: creating a new composite record (See column 5 lines 59-61), Linking the at least one publisher record identified in b to the new composite record (See column 5 lines 53-67), unlinking the at least one publisher record identified in b from the original composite record (See column 6 lines 40-57). It would have been obvious to an artisan of ordinary skill in the pertinent art to have incorporated, the teaching of Boothby into the system of Stoltenberg. The modification would have been obvious because records can be specified in many ways and linking and unlinking of records helps to maintain the integrity of the system (See Boothby column 1 lines 47-54, and see Stoltenberg paragraph 0007).

As for claim 11, the rejection of claim 10 is incorporated, and further Stoltenberg discloses: wherein a comprises receiving the selection of a menu selection item that is displayed in a general user interface that also displays contact data (See paragraph 0049 "unmerge button" and see paragraph 0038 "contact data").

As for claim 12 the rejection of claim 10 is incorporated, and further Boothby discloses: wherein the publishers records each correspond to a store (See column 5 lines 10-14, records correspond to handheld records and desktop records both stores since they are files which are accessed by an application) and B includes receiving a

Art Unit: 2166

command from the user that identifies one or more stores that that user does not want to synchronize with the original composite record (See column 8 lines 47-51 just set the flag to absent and it will not be synchronized).

As for claim 13, the rejection of claim 10 is incorporated, and further Boothbyv discloses: wherein the original composite record is part of a computer operating system (See column 5 lines 46-47 note: status file is saved in memory on the computer, and also note: the computer/CPU must have an operating system).

As for claim 14 Stoltenberg discloses:: (b) comparing the first order to the order of second contact data having elements arranged in a second order and corresponding to the contact (See paragraph 0036), and (c) when the first order is different from the second order, assigning an order to elements of a composite record corresponding to the contact (See paragraph 0036 note records are resorted based on score).

While Stoltenberg does disclose receiving first contact data having elements arranged in a first order and corresponding to a contact the disclosure is more explicit in Boothby. Boothby discloses (a) receiving first contact data having elements arranged in a first order and corresponding to a contact (See column 5 lines 1-6 records can be organized based on a unique ID). It would have been obvious to an artisan of ordinary skill in the pertinent art to have incorporated, the teachings of Boothby into to the system of Stoltenberg. The modification would have been obvious because Boothby works with

Art Unit: 2166

many different embodiments included structured list (See column 8 lines 58-64), and having an order to the records means that there is a central structure and you are using only a set number of fields for comparison (See Stoltenberg paragraph 0008).

As for claim 15 the rejection of claim 14 is incorporated, and further Stoltenberg discloses: wherein the order assigned in C is received from a user (See paragraph 0046, user can move ahead in the list bypassing records).

As for claim 16 the rejection of claim 14 is incorporated, and further Stoltenberg discloses: wherein the order assigned in c is determined by at least one rule. (See paragraph 0036 calculating a score is a rule).

As for claim 17 the rejection of claim 16 is incorporated, and further Stoltenberg discloses: wherein the at least one rule assigns priorities to the order of at least some of the of the composite based on the source of the corresponding data (See paragraph 0036 elements are worked in order and therefore stored in that same order).

As for claim 18, the rejection of claim 14 is incorporated, and further Boothby discloses: wherein the first contact data is included within a publisher record (See column 5 lines 22-28 not handheld record).

As for claim 19 the rejection of claim 18 is incorporated, and further Boothby discloses: wherein the second contact data is included within a publisher record (See column 5 lines 22-28 note: desktop record).

Response to Arguments

Applicant's arguments filed 7/21/06 have been fully considered but they are not persuasive.

Applicant argues:

There is not teaching or suggestion in paragraph 25 or the remainder of the reference of "contact records stored in a computer operating system" as claims in claim 1 and original claim 9.

Examiner responds:

Examiner is not persuaded. Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. Interpretation of Claims- Broadest Reasonable Interpretation During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA

1969). Broadly interpreted the contact records are stored in a computer operating system.

Applicant argues:

The office action never address the differences between the claimed composite and published records. Moreover, paragraph 49 of Stoltenberg merely describes the use of an unmerge button to unmerge a last record that was merged. There is no identification of at least one publisher record that the user wishes to unmerge.

Examiner responds:

Examiner is not persuaded. According to examiner Publisher records are just those records which are synchronized with a device, however when no inconsistencies occur between the synchronized published record and the composite record and they are both synchronized then the records in fact are the same record. Therefore using the unmerge button to unmerge the last record that was merged discloses identification of at least one publisher record that the user wished to unmerge.

Applicant Argues:

There is no mention of "unlinking " in the cited section of Boothby. Moreover, the words link and unlink are not found in any section of Boothby. The cited section of Boothby merely describes a synchronization process.

Examiner responds:

Examiner is not persuaded. While the cited section does not use the work link and unlink, the cited section does disclose that handheld records are correlated with pre-existing status file records. Examiner submits to applicant that correlating which is defined as establishing a relationship between is the same as linking.

Applicant argues:

There is no teaching or suggestion relating to the orders of elements within a record.

Examiner responds:

Examiner is not persuaded. Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. Interpretation of Claims- Broadest Reasonable Interpretation during patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.'

Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). Reference is made to MPEP 2144.01 - Implicit Disclosure

"[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)

Subsequent to an analysis of the claims it was revealed that a number of limitations recited in the claims belong in the prior art and thus encompassed and/or implicitly disclosed in the reference (s) applied and cited. It is logical for the examiner to focus on the limitations that are "crux of the invention" and not involve a lot of energy and time for the things that are not central to the invention, but peripheral. The examiner is aware of the duties to address each and every element of claims, however, it is also important that a person prosecuting a patent application before the Office or an stakeholders of patent granting process make effort to understand the level of one of ordinary skill in the (data processing) art or the level one of skilled in the (data processing) art, as encompassed by the applied and cited references. The administrative convenience derived from such a cooperation between the attorneys and examiners benefits the Office as well the patentee.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action. Paragraph 0036 discloses explicitly that all elements of a 1st record are compared against all the elements of a 2nd record. Implicitly one of ordinary skill in the art would see this as disclosing that the order is irrelevant and that even if the system receives a record in a 1st order and a 2nd record whose elements are arranged in a 2nd order the system will still compare the records and assign an order based on the result of the comparison.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leon J. Harper whose telephone number is 571-272-0759. The examiner can normally be reached on 7:30AM - 4:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2166

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LJH
Leon J. Harper
October 16, 2006


MOHAMMAD ALI
PRIMARY EXAMINER